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OFFICE OF PETITIONS

In re Patent No. 5,800,552 :
Issue Date: 09/01/1998 :
Application Number: 08/327092 : DECISION ON PETITION
Filing Date: 10/21/1994 :
Attorney Docket Number: :
6811013A :

This is a decision on the petition under 37 CFR 1.378(b),¹ filed on November 15, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f).

¹ A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(I)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was

taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued on September 1, 1998. The first maintenance fee was timely paid. The second maintenance fee could have been paid during the period from September 1, 2005, through March 1, 2006, or, with a surcharge, during the period from March 2 through September 1, 2006. The patent expired at midnight on September 1, 2006, for failure to timely pay the second maintenance fee.

Petitioner, Mark E. Forte, on behalf of assignee Implantology, LLC, states that the inventor is his father, Mark R. Forte, and that the patent was transferred to the assignee on June 30, 2010.

Petitioner further states that he recently discovered that the maintenance fee had not been paid. Petitioner further avers:

The transfer of Patent 5,800,552 ("Mechanically Linked Hinged Total Knee Prosthesis") to Implantology LLC occurred on June 30, 2010. The previous owner of the patent was my father, Mark Robert Forte. Transfer of this (and other patents) was initiated from an Estate Asset Plan that occurred within our family this year.

My father never disclosed to me the status of this or any other of his Patents, neither before or after the transfer. From my own due diligence, I very recently discovered a requirement of payments of maintenance fees that was not fulfilled.

A medical situation arose and continues to exist that caused an inadvertent and unavoidable delay of payment of these fees.

My father has recently been diagnosed with a moderate to severe level of Dementia relating to a form of Alzheimer's disease. The slow, degenerative nature of this condition lends credence to the fact that this disorder actually started some years ago and has been getting progressively worse since.

This condition has been the cause of his mental capabilities being affected for some time. This

includes his ability to remember recent events and a decreased and/or absence of ability to plan or organize.

Because of his condition, my father was not able to remember to make the required payments, or comprehend the seriousness of events that lack of payments would trigger. He had owned eight other patents, in which maintenance fees were also not made in a timely mater. However this is the only patent that has a suitable, remaining life span which makes reinstatement a serious consideration.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".² A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."³ This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."⁴ Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.⁵ Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁶ However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁷ In view of In re Patent No. 4,409,763,⁸ this same standard will be

² 35 U.S.C. § 41(c)(1).

³ Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

⁴ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁵ In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

⁶ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

⁷ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁸ 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.⁹ 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.¹⁰

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.¹¹ That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.¹²

At the outset, there are three periods to be considered during the evaluation of a petition under 37 CFR 1.378(b):

- (1) The delay in reply that originally resulted in expiration;
- (2) The delay in filing an initial petition pursuant to § 1.378(b) to revive the application; and
- (3) The delay in filing a *grantable* petition pursuant to § 1.378(b) to revive the application.¹³

The petition lacks the showing required by items (1) and (2).

⁹ See *Commissariat A. L'Energie Atomique v. Watson*, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

¹⁰ See *Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd* 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992); *Ray v. Lehman*, *supra*.

¹¹ *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788.

¹² *Id.*

¹³ See *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

With regard to period (1), while physical or mental incapacitation can be a cause of delay, a showing of "unavoidable" delay based upon incapacitation must establish that petitioner's incapacitation was of such a nature and degree as to render petitioner unable to conduct business (e.g. correspond with the Office) during the period between September 1, 2006, and the date of filing of the subject petition.

Such a showing must be supported by a statement from petitioner's treating physician, and such statement must provide the nature of petitioner's incapacitation during the above-mentioned period.

Additionally, petitioner must explain whether his father had sole responsibility for the payment of the maintenance fee, or if any other parties were involved in tracking and paying the maintenance fee. Statements from all individuals who had responsibility for tracking and paying the subject maintenance fee, setting forth the facts as they know them, are required with any renewed petition. If any other individual(s) in petitioners' family or business were aware that the maintenance fee was due in the subject patent, statement(s) from that individual(s) setting forth the facts as they know them are also required.

With regard to period (2), petitioner Mark E. Forte must explain when he learned that the patent had become expired. Petitioner must provide a documented showing that the delay between when petitioner learned that the patent had become expired, and the filing of the subject petition, was unavoidable.

Lastly, if the petition is being signed on behalf of the assignee, the person signing the petition must show that they are authorized to act on behalf of the assignee. 37 CFR 3.71(c). Accordingly, the attached Statement Under 37 CFR 3.73(b) must be completed and returned with any renewed petition.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the

public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

The address in the petition is different than the correspondence address. A courtesy copy of this decision is being mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. A change of correspondence address must be submitted if the correspondence address needs to be updated.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

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Telephone inquiries should be directed to the undersigned at 571-272-3231.

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